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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/455,109	12/06/1999	JAMES H. WOLFSTON JR.	P-01777-US1	4659

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EXAMINER

HONG, STEPHEN S

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 01/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant N .

09/455,109

Examiner

Stephen S. Hong

Applicant(s)

WOLFSTON ET AL.

Art Unit

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) 28-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 28-44 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: amendment filed on November 6, 2003 to the Application filed on 8/25/99.
2. In the amendment claims 28-44 have been added. Accordingly, claims 1-44 are pending in the case. Claims 1, 9, 15, 21 and 25 are independent claims.

Election/Restrictions

Newly submitted claims 28-44 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 28-44 are directed to the specific feature of providing communications which would have been searched in Class 709 subclass 203+, and that the newly added claims would have been restricted if originally presented as a subcombination invention with the earlier presented claims.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 28-44 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 7-12, 15-18 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Center for Metalloenzyme Studies: Summer Undergraduate Research Program (herein SURP; www.uga.edu/cms/SURP.html 3/1/1998).

4. Regarding independent claims 1, 9, and 15, SURP teaches presenting an application form over a computer network to an applicant, the application including at least one user-activateable hyperlink (the input boxes of the application are located on page 3 and hyperlinks are located on page 2, "first visit this page to select...," and page 3, "See this page for faculty list.").

SURP does not explicitly teach, upon activation of the hyperlink, displaying a communication to the applicant from an identified individual associated with the institution, thereby encouraging the applicant to complete the application by socializing the application process with a communication to the applicant from the identified individual. However, SURP does teach, upon activation of the hyperlink, displaying a web page from which a user can access a communication to the applicant from an identified individual associated with the institution, thereby encouraging the applicant to complete the application by socializing the application process with a communication to the applicant from the identified individual. When either of the previously mentioned hyperlinks is activated, the CMS Faculty page is retrieved, displaying a list of professors associated with the university. Further activation of the hyperlinks associated with each faculty member retrieves a communication from the respective faculty member. It would

have been obvious to one of ordinary skill in the art at the time of the invention to modify SURP so that the hyperlink located on the application would have retrieved the communication as well. Such would have been done if fewer professors were involved to not require extra clicks from a user or to present the communications to the user quicker.

5. **Regarding dependent claim 2**, SURP teaches the institution being a college or university and the identified individual being a student, faculty member, or alumnus associated with the institution (the institution is associated with the University of Georgia and the individuals are professors).

6. **Regarding dependent claims 3, 10, and 16**, SURP teaches the communication describing the individual and providing a means of communication (the professors display names and backgrounds and provide e-mails, see the individual faculty pages, e.g. Harry A. Dailey).

7. **Regarding dependent claim 4**, SURP teaches the communication including a still or motion image of the individual (photos are shown of most professors, see CMS Faculty and the individual faculty pages).

8. **Regarding dependent claim 7**, SURP teaches the communication including contact information (the professors provide e-mails, see the individual faculty pages, e.g. Harry A. Dailey).

9. **Regarding dependent claim 8**, SURP teaches providing to the user a response when an application is completed, the response containing a message from an individual associated with the university and a means of contacting the individual. This means of contact is available only after a user completes the application and submits it.

10. **Regarding dependent claims 11 and 17**, SURP teaches the communication including a new Web Page and a description of the individual (see CMS Faculty and the individual faculty pages). SURP does not explicitly teach the communication including a Web Page in a pop-up window. However, it was known and typical in the art at the time of the invention for new browser windows to be presented in either the same window as the activated link, or presented in a new window acting as a pop-up window. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify SURP in order to enable the associated pages to appear in a pop-up window. This would have given the user the ability to view both the communication and the application at the same time, allowing the user to continue filling out the application, copy and paste information between windows easily, and read the communication at will.

11. **Regarding dependent claim 12 and 18**, the claim incorporates substantially similar subject matter as claim 1, and is rejected along the same rationale.

Claims 5-6, 13-14, 19-27 remain rejected under 35 U.S.C. 103(a) as being unpatentable over SURP in view of Popp et al (herein Popp; USPN 6249291 – filing date 9/22/1995).

12. **Regarding dependent claims 5, 13, 14, and 19**, SURP does not explicitly teach the communication content being dependent on information entered into the form.

However, Popp does teach delivering a web page to a user wherein the web page is a response to a user that depends on a user's input (col 3, ln 35-40 and 57-63). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine SURP and Popp. Such a combination would have made the creation of the application web page easier by implementing an object-oriented paradigm.

13. **Regarding dependent claim 6**, SURP does not explicitly teach the communication content being assembled in response to activation of the hyperlink.

However, Popp does teach the dynamic creation of a web page (col 3, ln 35-40 and 57-63). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Popp and SURP in such a way to dynamically assemble content in response to the activation of a hyperlink. This would have allowed a web page to be responsive to user input on a prior page. For example, if a number of SURP applicants had already chosen a professor with whom they want to do research a responsive web page could inform the applicant to choose a different professor, or address a different problematic input error.

14. **Regarding dependent claim 20**, SURP does not explicitly teach the communication being constructed from components. However, Popp does teach the construction of web pages by using various components (col 4, ln 41-47). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine

SURP and Popp. Such a combination would have made the creation of the application web page easier by implementing an object-oriented paradigm.

15. **Regarding independent claims 21 and 25**, SURP teaches presenting an electronic form over a computer network to the user, the form including plural information fields and at least one user-activateable hyperlink that is activateable by the user after the user enters information into one or more predefined information fields of the form (the information fields of the form are located on page 3 and hyperlinks, activateable after the user enters information into one or more of the fields, are located on page 2, “*first visit this page to select...*,” and page 3, “*See this page for faculty list.*” Of the CMS: Summer Undergraduate Research Program web page).

16. SURP teaches, upon activation of the hyperlink, displaying to the user information that relates to the underlying purpose of the form. SURP does not explicitly teach displaying customized information that is parametrically customized according to information in one or more of the predefined information fields. However, Popp does teach delivering information to a user wherein the information is a response to a user and the information is customized based on input provided by the user in the previous page (col 3, ln 35-40 and 57-63). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine SURP and Popp. Such a combination would have made the creation of the application web page easier by implementing an object-oriented paradigm and would have better informed users by enabling custom messages to be presented to users.

17. **Regarding dependent claim 22 and 26**, SURP teaches including a communication to a user from an identified individual associated with the institution. When either of the hyperlink located on the CMS: Summer Undergraduate Research Program web page are activated, the CMS Faculty page is retrieved, displaying a list of professors associated with the university and communications regarding their respective work. Further activation of the hyperlinks associated with each faculty member retrieves an extended communication from the respective faculty member.

18. **Regarding dependent claim 23 and 27**, SURP teaches an institution being a college or university. SURP does not explicitly teach an admission form into a college. However, SURP does teach a college-associated research program admission form. It would have been obvious to one of ordinary skill in the art at the time of the invention to use similar means with standard college admission forms. This would have made applying to the school easier, cheaper, and faster for many students with Internet access.

19. **Regarding dependent claim 24**, SURP teaches communication information that does not explicitly relate to instructions for completing the application (see CMS Faculty and the individual faculty pages).

Response to Arguments

20. Applicant's arguments filed on November 6, 2003 have been fully considered but they are not persuasive.

On page 8 of the amendment, Applicant provides the following arguments:

Claim 1 is a method of encouraging completion of forms through the introduction "during forms processing of appropriate communication to the applicant..."

SURP teaches viewing faculty advisor web pages before the student begins to complete the form, not "during forms processing." SURP states "[F]irst visit this page to select your three choices of faculty advisor, then submit the online application form at the bottom of this page..."

Applicant addresses and solves the problem of individuals beginning to complete a form and then failing to complete it. The number of admission application received by a school can be reduced because some students that begin a lengthy admissions form lack the motivation to complete the form. By encouraging completion of a form once started, the number of admissions applications can be increased. This problem is not addressed in SURP, in which the links are accessed before beginning the form. Taking the SURP reference as a whole for what it teaches, it teaches selecting a faculty advisor and then completing the form.

Examiner disagrees with the argument. It should be note that the Claims define the metes and bounds of the invention. In the instant case, the claim, specifically in the preamble, states "during forms processing of appropriate communication to the applicant..." However, the claim does not *limit* as to what can be considered as the "forms processing." In SURP, the "forms processing" consists of several steps that include visiting the initial page and the filling out the actual form fields. It appears that the Applicant may be arguing that the forms processing is limited to when the form page is being displayed on the screen. Nevertheless, there is no claimed limitation that requires the form processing session to be limited in such way. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, Applicant should note that a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended

use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen S. Hong whose telephone number is (703) 308-5465. The examiner can normally be reached on Monday to Friday, 9:00am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (703) 308-5186. The fax phone

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number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



Stephen Hong
Primary Examiner
Art Unit 2178
January 9, 2004